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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/665,065      | 09/19/2000  | Kamel Shaath         | 38898-172161        | 5244             |

26694 7590 10/08/2004

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| EXAMINER |
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KALINOWSKI, ALEXANDER G

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3626

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

**Application No.**

09/665,065

**Applicant(s)**

SHAATH ET AL.

**Examiner**

Alexander Kalinowski

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 38-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 38-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 1-13 and 38-46 are presented for examination. Applicant filed an amendment on 6/28/04, amending claims 1, 8, 38, and 43.

### ***Response to Amendment***

2. The affidavit under 37 CFR 1.132 filed 6/28/04 is insufficient to overcome the rejection of claim 1-13 and based upon Shaath, Pat. No. 6,438,642 based on 35 USC 102 as set forth in the last Office action because: the affidavit presents contradictory statements as to the inventorship of the '642 patent. In the affidavit, Applicant argues that Applicant believes that he is the original and sole inventor of the '642 patent. This statement contradicts the next statement in the declaration where Applicant states that subject matter disclosed but not claimed in the '642 patent is derived from Applicant's contributions and are not an invention by another. Therefore, the affidavit is insufficient to overcome the rejection of the claims.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-13 and 38-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaath et al. , Pat. No 6,438,642 (hereinafter Shaath).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 1, 8, and 38, 44-46, Shaath discloses A computer implemented method of managing a file lifecycle comprising the steps of storing the file on a storage medium accessible by a computer having associated therewith a set of policies relating to file storage locations (Fig. 7 and col. 4, lines 7-14 and line 64 – col. 5, lines 28); automatically determining from the associated policies when the file is to be moved (col. 4, line 64 – col. 5, line 28); and, moving the file to another storage location within a same or different storage medium when the file is to be moved (col. 5, lines 13-28).

As to claims 2, Shaath discloses A method of managing a file lifecycle according to claim 1 comprising the steps of providing a plurality of storage media including the storage medium, each having associated therewith a set of policies, the policies such

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that when a condition is met the file is transferred from one storage medium to another in accordance with a lifecycle stage of the file (i.e. archiving server ... cd-rom for archiving)(col. 5, lines 13-28).

As to claims 3, 9, 39, Shaath discloses A method of managing a file lifecycle according to claim 2 wherein a first storage medium is associated with active files and a last storage medium is associated with archived files and wherein the file is transferred from the first storage medium to the last storage medium in successive stages (col. 5, lines 13-28).

As to claims 4, 10, 40, Shaath discloses A method of managing a file lifecycle according to claim 3, wherein a file is automatically transferred to a storage medium most appropriate for its stage of lifecycle determined in accordance with the policies (col. 5, lines 13-28).

As to claims 5, 11, 41, Shaath discloses A method of managing a file lifecycle according to claim 4 wherein the policies relate to at least some of the associated storage medium, the file name, the file extension, the file creation date, the file access date, the file last access date, the file creator, and the current file owner (col. 5, lines 13-28).

As to claims 6, 12, 42, Shaath discloses A method of managing a file lifecycle according to claim 1 wherein the step of storing the file on a storage medium comprises the step of determining, in accordance with the policies, expiration data relating to when the file is to be moved (col. 5, lines 13-28).

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As to claims 7, 13, 43, Shaath discloses A method of managing a file lifecycle according to claim 6 wherein the step of automatically determining when the file is to be moved comprises the step of comparing the expiration data to present time data to determine if it is indicative of the file having expired its time on the storage medium or on the entire system (col. 5, lines 13-28).

### ***Response to Arguments***

5. Applicant's arguments filed 6/28/04 have been fully considered but they are not persuasive. The affidavit as explained above does not overcome the 35 USC 103 rejection of the claims. Therefore, Applicant's arguments directed to the 35 USC 103 rejection of claims 1-13 and 38-46 are non persuasive.

6. Based on Applicant 's amendment to the claims, the Examiner withdraws the rejection of claims based on 35 USC 101.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

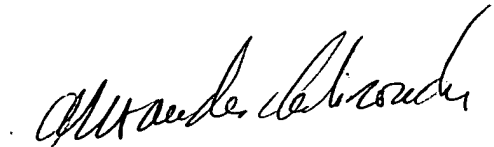
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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10/3/2004